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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,935

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EXAMINER

MILIA, MARK R

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

02/14/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/730,935

Applicant(s)

SUGIMOTO ET AL.

Examiner

Mark R. Milia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 30 reference numeral **623**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because it is more than one paragraph. Correction is required. See MPEP § 608.01(b).

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3. The disclosure is objected to because of the following informalities: On page 57, line 15, reference numeral **562** should be **552** and **563** should be **553**. Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-14 and 27-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8-14 and 27-35 drawn to functional descriptive material NOT claimed as residing on a computer readable medium.

Claims 8-14 and 27-35, while defining an image forming program, does not define a "computer-readable medium" and is thus non-statutory for that reasons. An image forming program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 7-8, 14-18, 25-27, 34, and 37-38 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0140958 to Lester.

Regarding claims 1, 8, 15, and 16, Lester discloses an image forming device, program, and method for receiving a document file and forming images of said document file, wherein said document file contains objects for displaying a part or all of the contents of each page of the document and being capable of lining up in the file regardless of the order of said contents displayed in said document, comprising: a receiving unit for successively receiving constituent data of said document file (see Figs. 1-3 and paragraphs 8 and 41), a storing unit for successively storing said objects contained in said constituent data received by said receiving unit (see paragraphs 42-44), a judging unit for judging whether all objects necessary for displaying a specific page are stored in said storing unit (see Fig. 5 and paragraph 44), and an image forming unit for forming images of said specific page when it is judged by said judging unit that all objects necessary for displaying said specific page are stored in said storing unit (see Fig. 5 and paragraph 44).

Regarding claims 18, 27, and 36-37, Lester discloses an image forming device, program, and method for receiving a document file and forming images of said document file, wherein said document file contains objects for displaying a part or all of the contents of each page of the document and being capable of lining up in the file regardless of the order of said contents displayed in said document, comprising: a receiving unit for successively receiving constituent data of said document file (see Figs. 1-3 and paragraphs 8 and 41), a storing unit for successively storing said objects contained in said constituent data received by said receiving unit (see paragraphs 42-44), an image forming unit for forming images of said objects stored in said storing unit either singly or in combination of two or more of them regardless of the order displayed in said document (see Fig. 5 and paragraph 44).

Regarding claims 7, 14, 17, 26, and 38, Lester further discloses wherein said document file is a PDF file (see paragraphs 8 and 39-48).

Regarding claims 25 and 34, Lester further discloses wherein said image forming unit forms images of said object in the order stored in said storing unit (see paragraphs 39-44).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3, 5-6, 9-10, 12-13, 24, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester as applied to claims 1, 8, 16, 18, 27, and 37 above, and further in view of U.S. Patent No. 6,407,821 to Hohensee et al.

Regarding claims 2 and 9, Lester does not disclose expressly wherein said specific page is a head page among pages whose images have not been formed.

Hohensee discloses wherein said specific page is a head page among pages whose images have not been formed (see Fig. 6 and column 2 lines 5-25).

Regarding claims 3, 10, 24, and 33, Lester does not disclose expressly a deleting unit for deleting a specific object which has already been stored in said storing unit.

Hohensee discloses a deleting unit for deleting a specific object which has already been stored in said storing unit (see Figs. 2 and 6 and column 9 lines 58-63).

Lester & Hohensee are combinable because they are from the same field of endeavor, printing of PDF files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the deleting of redundant objects that have previously been stored, as described by Hohensee, with the system of Lester.

The suggestion/motivation for doing so would have been to decrease the memory needed to store a PDF file for printing and to avoid downloading redundant resources (see column 3 lines 10-15 of Hohensee).

Therefore, it would have been obvious to combine Hohensee with Lester to obtain the invention as specified in claims 2-3, 9-10, 24, and 33.

Regarding claims 5 and 12, Hohensee further discloses wherein said specific object is an object which is not necessary for displaying other pages whose images have not been formed among objects used for displaying pages whose images have been formed (see Figs. 2 and 6 and column 9 lines 58-63).

Regarding claims 6 and 13, Hohensee further discloses a transmitting unit for transmitting a transmission request concerning the deleted object when an object for displaying said specific page is deleted from said storing unit by said deleting unit (see column 5 lines 36-51).

9. Claims 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester as applied to claims 18 and 27 above, and further in view of Hohensee.

Lester does not disclose expressly an identification name assigning unit for assigning identification names to said objects stored in said storing unit, wherein said image forming unit forms images of said objects together with the identification names assigned to said objects by said identification name assigning unit.

Hohensee discloses an identification name assigning unit for assigning identification names to said objects stored in said storing unit, wherein said image forming unit forms images of said objects together with the identification names assigned to said objects by said identification name assigning unit (see Fig. 6, column 9 line 43-column 10 line 30, and column 11 lines 36-52).

Lester & Hohensee are combinable because they are from the same field of endeavor, printing of PDF files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the identification names of objects, as described by Hohensee, with the system of Lester.

The suggestion/motivation for doing so would have been to ensure proper preservation of data objects and to avoid downloading redundant resources (see column3 lines 10-15 of Hohensee).

Therefore, it would have been obvious to combine Hohensee with Lester to obtain the invention as specified in claims 19 and 28.

10. Claims 20-22 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester and Hohensee as applied to claims 19 and 27 above, and further in view of U.S. Patent Application Publication No. 2004/0216048 to Brown et al.

Regarding claims 20 and 29, Hohensee discloses an identification name information generating unit for generating identification name information which is information on the identification names of said objects contained in each page of said document (see Fig. 6, column 9 line 43-column 10 line 30, and column 11 lines 36-52).

Lester and Hohensee do not disclose expressly wherein said image forming unit further forms images of the identification name information generated by said identification name information generating unit.

Brown discloses wherein said image forming unit further forms images of the identification name information generated by said identification name information generating unit (see paragraph 38).

Regarding claim 21 and 30, Lester and Hohensee do not disclose expressly wherein said identification name information contains table of contents which displays each page number of said document and the identification names of said objects contained in the page related to said page number.

Brown discloses wherein said identification name information contains table of contents which displays each page number of said document and the identification names of said objects contained in the page related to said page number (see paragraph 38).

Regarding claims 22 and 31, Lester and Hohensee do not disclose expressly wherein said identification name information contains page information which displays the identification names of said objects contained in a specific page of said document and the identification name of said specific page, and list of pages which displays each page number of said document and the identification name of a page related to said page number.

Brown discloses wherein said identification name information contains page information which displays the identification names of said objects contained in a specific page of said document and the identification name of said specific page, and list of pages which displays each page number of said document and the identification name of a page related to said page number (see paragraph 38).

Lester, Hohensee, & Brown are combinable because they are from the same field of endeavor, printing of PDF files.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the printing of a table of contents, which inherently contains page numbers associated with document data (object names), as described by Brown, with the system of Lester and Hohensee because table of contents are a well known and commonly used method of informing a user of the location of specific data to allow the user to easily locate desired information thereby saving the user time and effort.

Therefore, it would have been obvious to combine Brown with Lester and Hohensee to obtain the invention as specified in claims 20-22 and 29-31.

11. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester and Hohensee as applied to claims 3 and 10 above, and further in view of Japanese Patent Document No. 09-174955 to Abe as cited on the IDS dated 6/20/07. Reference will be made to a computer translation which is being furnished with this Office Action.

Lester and Hohensee do not disclose expressly a second judging unit for judging whether the amount of usage of said storing unit has exceeded a prescribed limit of usage, wherein said deleting unit is to delete said specific object from said storing unit when it is judged by said second judging unit that the amount of usage of said storing unit has exceeded the prescribed limit of usage.

Abe discloses a second judging unit for judging whether the amount of usage of said storing unit has exceeded a prescribed limit of usage, wherein said deleting unit is to delete said specific object from said storing unit when it is judged by said second judging unit that the amount of usage of said storing unit has exceeded the prescribed limit of usage (see paragraphs 13 and 14).

Lester, Hohensee, & Abe are combinable because they are from the same field of endeavor, printing of document data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the deletion of specific objects when a storage capacity threshold is reached, as described by Abe, with the system of Lester and Hohensee.

The suggestion/motivation for doing so would have been to allow systems with a relatively small memory capacity, which saves system costs, to be able to process and print PDF files.

Therefore, it would have been obvious to combine Abe with Lester and Hohensee to obtain the invention as specified in claims 4 and 11.

12. Claims 23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lester as applied to claims 18 and 27 above, and further in view of Japanese Patent Document No. 09-174955 to Abe as cited on the IDS dated 6/20/07. Reference will be made to a computer translation which is being furnished with this Office Action.

Lester does not disclose expressly a second judging unit for judging whether the amount of usage of said storing unit has exceeded a prescribed limit of usage, wherein

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said deleting unit is to delete said specific object from said storing unit when it is judged by said second judging unit that the amount of usage of said storing unit has exceeded the prescribed limit of usage.

Abe discloses a second judging unit for judging whether the amount of usage of said storing unit has exceeded a prescribed limit of usage, wherein said deleting unit is to delete said specific object from said storing unit when it is judged by said second judging unit that the amount of usage of said storing unit has exceeded the prescribed limit of usage (see paragraphs 13 and 14).

Lester & Abe are combinable because they are from the same field of endeavor, printing of document data.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the deletion of specific objects when a storage capacity threshold is reached, as described by Abe, with the system of Lester.

The suggestion/motivation for doing so would have been to allow systems with a relatively small memory capacity, which saves system costs, to be able to process and print PDF files.

Therefore, it would have been obvious to combine Abe with Lester to obtain the invention as specified in claims 23 and 32.

Conclusion

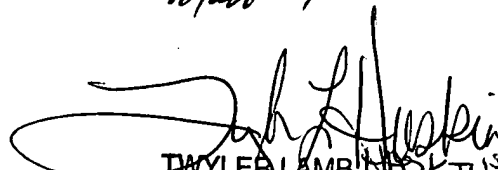
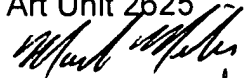
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Haskins can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MRM

Mark R. Milia
Examiner
Art Unit 2625



TWYLER LAMB HASKINS
SUPERVISORY PATENT EXAMINER